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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,470	05/24/2001	Frederick L. Ross	067439.0119	2938

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EXAMINER	
THEIN, MARIA TERESA T	

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 08/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/865,470	ROSS, FREDERICK L.	
	Examiner	Art Unit	
	Marissa Thein	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 May 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *24 May 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *3,7-8, 10*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement (IDS) submitted on August 21, 2001, May 24, 2001, July 3, 2002, and August 25, 2002 are being considered by the examiner.

Drawings

The drawings filed on May 24, 2001 are acceptable.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. The claimed invention must utilize technology in a non-trivial manner. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow

apply, involve, use, or advance the technological arts. For example in claim 1, the method claim recites "a public communication network" in the preamble of the claim and the body of the claim which is a trivial use of the technology. Therefore, the claim is nothing more than an abstract idea, which is not tied to any technological art and is not a useful art. *Ex parte Bowman*, 61 USPQ2d 1665, 1671 (BD, Pats. App. & Inter. 2001). See MPEP 2106 IV 2(b).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7, 10-17, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,085,172 to Junger.

Regarding claim 1, Junger discloses a method of using a public communications network to manage the return of an item purchased by a consumer from a remote direct merchandiser, comprising the steps of:

- receiving return request data from a local returns site (see at least col. 2, lines 41-46; col. 5, lines 5-35; Figures 4A-4B);

- providing return validation data to the local returns site, the return validation data having at least a return validation code (see at least col. 2, lines 46-52; col. 6, lines 30-36; col. 6, line 59- col. 7, line 6);
- attempting a match between the return validation code and a code provided by the consumer (see at least col. 2. lines 46-56; col. 6, lines 57 – col. 7, line 6);
- wherein each of the above steps is performed using a public communication network (see at least col. 4, lines 39-54).

The recitation "if a match exits, crediting an account of the consumer for a return value of the returned item" is given little patentability weight because it is a hypothetical act or an alternative that need not be performed. Furthermore, alternatives that are not required to be performed are not an act. Nonetheless, Junger discloses matching exists, crediting an account of the consumer for a return value of the returned item (see at least col. 3, lines 61-64; col. 4, lines 14-16; col. 8, lines 58-67).

Regarding claims 2-4 and 12-14, Junger discloses Internet; public network; and a combination of Internet access and public telephone access (see at least col. 4, lines 39-54).

Regarding claims 5-6 and 15-16, Junger discloses receiving a request for general returns information from the consumer and of providing data representing general returns information to the consumer; and website (see at least col. 2, lines 44-58; col. 5, lines 9-15; col. 6, lines11-20; col. 6, lines 30-46).

Regarding 7, 10, 17 and 20, Junger discloses accessing return policy data representing disposal of the item as desired by the direct merchandiser; and website (see at least col. 5, lines 9-15; col. 6, lines 58-64; col. 7, lines 7-17; col. 8, lines 42-44).

Regarding claim 11, Junger discloses a method of using a public communications network to manage the return of an item purchased by a consumer from a remote direct merchandiser, comprising the steps of:

- receiving return request data from a local shipper (see at least col. 2, lines 56-60; col. 4, lines 7-19);
- providing return validation data to the local returns site, the return validation data having at least a return validation code (see at least col. 2, lines 46-52; col. 6, lines 30-36; col. 6, line 59- col. 7, line 6);
- attempting a match between the return validation code and a code provided by the consumer (see at least col. 2. lines 46-56; col. 6, lines 57 – col. 7, line 6);
- wherein each of the above steps is performed using a public communication network (see at least col. 4, lines 39-54).

The recitation "if a match exits, crediting an account of the consumer for a return value of the returned item" is given little patentability weight because it is a hypothetical act or an alternative that need not be performed. Furthermore, alternatives that are not required to be performed are not an act. Nonetheless, Junger discloses matching exists, crediting an account of the consumer for a return value of the returned item (see at least col. 3, lines 61-64; col. 4, lines 14-16; col. 8, lines 58-67).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 8-9 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent no. 6,085,172 to Junger.

Regarding claims 8-9 and 18-19, Junger discloses providing a returns validation code to the consumer and the step of receiving return request data from the local returns site; and website. However, Junger does not disclose the step of providing a return validation code to the consumer is prior to the step of receiving return request data from the local returns site. The differences are only found in the order of the steps and do not alter the stated purpose of the invention. Thus, merely reciting an order of the steps of a method claim which accomplishes the same result is not sufficient to distinguish over the prior art. *In re Altiris Inc. v. Symantec Corp.*, 65 USPQ2d 1865 (CAFC 2003).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to providing a return validation code step prior to the receiving return request data step because such order of steps does not alter the purpose of the invention and because the subjective interpretation of the order does not patentably distinguish the claimed invention.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6,016,480 to Houvener et al. discloses a system and method for return fraud prevention which includes a point of return terminal.

U.S. Patent No. 6,296,344 to Junger discloses a method and apparatus for efficient handling of product returns to reduce associated cost.

U.S. Patent No. 6,754,637 to Stenz discloses a method on the return processing server for managing the return processing of one or more manufactures.

U.S. Patent Application Publication No. 2001/0032141 to Drattell discloses a method of providing retailers with an outsourced return center fro processing merchandise returns.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 703-305-5246. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Smith can be reached on 703-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mtot
July 30, 2004

Jeffrey A. Smith
Primary Examiner